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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,772	09/18/2001	Toan Trinh	6009RXD	8802

27752 7590 10/09/2002

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EXAMINER	
HARDEE, JOHN R	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/954,772	TRINH ET AL.	
	Examiner	Art Unit	
	John R Hardee	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *124-145* is/are pending in the application.

4a) Of the above claim(s) *126-145* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *124 and 125* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Applicant's second preliminary amendment has been matched with the case. The present numbering of the claims as 124-145 has been preserved.

Election/Restrictions

2. Applicant's election with traverse of Group IAa in Paper No. 4 is acknowledged. The traversal is on the ground(s) that a serious burden has not been demonstrated, and that the examiner has not demonstrated that the inventions are independent or distinct. This is not found persuasive because in the case of the burden, applicant has claimed an infinite number ("at least one additional CH_2 group") of solvents in addition to 500-1000 solvents which are specified. The burden is self evident. Regarding independence and distinctness, applicant has not stated that the inventions are related. In addition, the fields of search for inventions a-c are different, since one would search 7-carbon diols for Group a, 8-carbon diols for Group b and 9-carbon diols for Group c.

The requirement is still deemed proper and is therefore made FINAL.

Claims 126-145 are withdrawn from consideration by the examiner as being drawn to non-elected inventions. Applicant may rejoin claims drawn to premixes, fabric softeners and butyraldehyde content which recite the saturated C7 diols found to be allowable.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 24 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2, at least, of U.S. Patent No. 6,369,025 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because this claim recites fabric softening compositions comprising the solvents recited by applicant. As such, claim 2 of the patent anticipates these claims.

5. Claims 24 and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11, at least of U.S. Patent No. US 6,323,172 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because this claim recites fabric softening compositions comprising the solvents recited by applicant. As such, claim 11 of the patent anticipates these claims.

Claim Objections

6. Claims 124 and 125 are objected to because of the following informalities: Both claims recite 2,3-dimethyl-3-4-pentanediol twice. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 124 and 125 are rejected under 35 U.S.C. 102(b) as being anticipated by any of Katzenellenbogen et al., Martin et al., Eliel et al and Green et al. Katzenellenbogen et al., discloses the preparation of 3,4-dimethyl-2,3-pentanediol at Table II, entry 11. Martin et al. discloses the preparation of 4-methyl-2,3-hexanediol. See figs. 13-16. Eliel et al. discloses the preparation of 2,3,3-trimethyl-1,2-butanediol. See the final product of Scheme 2. While one OH is distorted, it is clear from the text that this is a glycol. Green et al. also discloses the preparation of 2,3,3-trimethyl-1,2-butane diol. See Table 4, R=t-butyl.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 124 and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Katzenellenbogen et al., Martin et al., Eliel et al and Green et al. The claims are obvious because they are anticipated. Anticipation is the epitome of obviousness. In addition, the two 7-carbon diols which are not anticipated by these references are simple structural isomers of those which are anticipated. As such, they would be

expected by the person of ordinary skill in the art to have similar properties to the disclosed compounds, and they are therefore obvious over those which are anticipated.

13. Any prior art made of record and not relied upon is of interest and is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

John R. Hardee
Primary Examiner
July 17, 2002